

REMARKS

Claim 21 has been amended in accordance with the Examiner's request to replace "and" in claim 21, line 2 with "an".

The Examiner stated that the indicated allowability of claims 2, 3, 13, and 14 is withdrawn in view of the newly discovered reference(s) to Walker et al. (US Patent No. 6,566,066). Rejections based on the newly cited reference(s) follow.

Objections to the Disclosure

The Examiner stated that the disclosure is objected to because of the following informalities.

- (a) In claim 21, line 2, "and" should be changed to "an", and that appropriate correction is required.

Claim 21 has been so amended.

- (b) The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01. Embedded hyperlinks and/or other form of browser-executable codes appear in at least page 20, line 29.

Applicants submit that this recitation, as well as another at page 19, line 19, were deleted in a previous amendment filed April 16, 2003.

Applicants therefore request withdrawal of the objections to claims.

35 U.S.C. § 112, First Paragraph, Rejection of Claim 21

The Examiner has rejected claim 21 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner stated that the claim(s) contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor(s), at the time the application was filed, has possession of the claimed invention. This reason is repeated for reasons already of record (e.g., Office Action mailed July 1, 2003). Applicants arguments (paper filed August 25, 2003 at page 5) are most unconvincing because no basis is seen for claim 21. Neither page 3 nor page 23 of the instant application mentions all sequences that encode SEQ ID NOs: 14 and/or 15.

Applicants Response

The PTO has determined that the identification of all polynucleotide sequences encoding a disclosed protein sequence is routine in the art based on the well known genetic code . See Guidelines for Examination of Patent Applications Under 35 U.S.C. 112, ¶ 1, “Written Description” Requirement, Federal Register, Vol. 66, No. 4, Friday January 5, 2001, page 1102.

The Revised Written Description Guidelines Training Materials further address this issue specifically as it relates to polynucleotides encoding SEQ ID NO:14 and 15, as recited in instant claim 21, in Example 17 of the Training Materials, where it states that a claim drawn to all DNA sequences encoding a disclosed amino acid sequence of SEQ ID NO:2, based on the disclosure of a single encoding DNA sequence of SEQ ID NO:1, meets the written description requirements of 35 U.S.C. § 112, first paragraph because “a person of skill in the art could readily envision all DNAs degenerate to SEQ ID NO:1 by using a genetic code table. One of skill in the art would conclude applicant was in possession of the genus based on the specification and the general knowledge in art concerning a genetic coding table”.

Therefore, applicants submit that claim 21 reciting an isolated polynucleotide encoding a polypeptide having an amino acid sequence of SEQ ID NO:14 or 15 is adequately described in the specification based on the disclosure in the specification at page 23 of a species of polynucleotide of SEQ ID NOs:1 and 8, encoding the amino acid sequences of SEQ ID NO:14 and 15, respectively, and the general knowledge in the art concerning the genetic code.

Withdrawal of the rejection of claim 21 under 35 U.S.C. § 112, first paragraph is therefore requested.

Obviousness-Type Double Patenting, Rejection of Claims 2, 3, 13-15, and 21

The Examiner has rejected claims 2, 3, 13-15, and 21 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 8-10 and 13 of U.S. Patent No. 6,566,066. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims embrace or are embraced by claims 2, 3, and 13-15 of the instant application. SEQ ID NO:8 of the instant application is identical to SEQ ID NO:2 of U.S. Patent No. 6,566,066 and SEQ ID NO:15 of the instant application is identical to SEQ ID NO:1 of U.S. Patent No. 6,566,066.

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to

overcome an actual or provisional rejection on this grounds.

Applicants Response

A terminal disclaimer will be timely filed in response to this rejection pending resolution of other outstanding rejections of these claims.

The Examiner concluded by stating that claim 1 is allowable over the prior art of record.

CONCLUSION

In light of the above amendments and remarks, Applicants submit that the present application is fully in condition for allowance, and request that the Examiner withdraw the outstanding objections/rejections. Early notice to that effect is earnestly solicited. Applicants further request that, upon allowance of claims 1 and 2, claims 4-12 be rejoined and examined as methods of use of the polynucleotides of claims 1 and 2 that depend from and are of the same scope as claims 1 and 2 in accordance with *In re Ochiai* and the MPEP § 821.04. Applicants further reserve the right to resubmit the Notice of Appeal, previously filed on September 30, 2003, in order to accommodate the additional claims rejected in the second Final Office Action, in the event that the Examiner maintains these rejections.

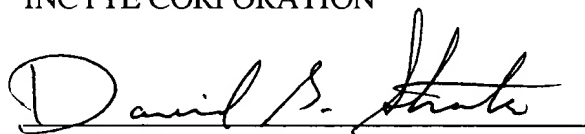
If the Examiner contemplates other action, or if a telephone conference would expedite allowance of the claims, Applicants invite the Examiner to contact the undersigned at the number listed below.

Applicants believe that no fee is due with this communication. However, if the USPTO determines that a fee is due, the Commissioner is hereby authorized to charge Deposit Account No. **09-0108**.

Respectfully submitted,

INCYTE CORPORATION

Date: December 18, 2003



David G. Streeter, Ph.D.

Reg. No. 43,168

Direct Dial Telephone: (650) 845-5741

Customer No.: 27904
3160 Porter Drive
Palo Alto, California 94304
Phone: (650) 855-0555
Fax: (650) 849-8886